

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Confirmation No.: 1642

Krisztian KISS, *et al.*

Art Unit: 2478

Application No.: 10/733,635

Examiner: Sulaiman NOORISTANY

Filed: December 12, 2003

For: REGISTRATIONS IN A COMMUNICATION SYSTEM

Mail Stop Pre-Appeal

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Pre-Appeal Brief Request for Review

This Pre-Appeal Brief Request for Review is with regards to the Office action mailed November 9, 2010. No amendments are being filed with this Request. This Request is being filed with a Notice of Appeal. Reconsideration and Allowance is respectfully requested in view of the Remarks contained in the following pages.

CERTIFICATE OF ELECTRONIC TRANSMISSION

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February 9, 2011
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Maria Fambro
Typed or Printed Name of Person Signing Certificate

Status of Claims

Claims 1, 4-5, 7-9, 11, 20, and 26-30 stand rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 7,177,642 to Sanchez-Herrero et al. (Sanchez) in view of Rosenberg et al., “Caller Preferences and Callee Capabilities for the Session Initiation Protocol (Rosenberg).

A. Neither Sanchez nor Rosenberg discloses or suggests “registering, in a controller entity comprising a call state control function, a plurality of contact addresses for a user,” as recited in claim 1.

The Examiner has taken an unreasonable construction of the claimed “registering, in a controller entity comprising a call state control function, a plurality of contact addresses for a user.”¹ In particular, the Examiner alleges that Sanchez’s disclosure at paragraphs 0011, 0047, 0062, and 0063 teaches the above-noted feature of claim 1 stating:

registering, in a controller entity comprising a call state control function is met by Sanchez [sic] ([0047]; [0062-0063, 0066] e.g., the CSCF (Service Requester Node) receives a REGISTER request (S-10), a plurality of contact addresses for a user is met by Sanchez ([0011]) e.g., plurality of identifiers under different service environments);

Office Action at page 3. But it is clear that Sanchez does not disclose the presence of a plurality of contact addresses at the call state control function, much less “registering, in a controller entity comprising a call state control function, a plurality of contact addresses for a user.” Rather than the service descriptor node (which is alleged by the Examiner to constitute a CSCF), Sanchez instead discloses that the user distribution system (UDS) includes a plurality of identifiers. *However, it would be unreasonable, and thus a clear error, to allege that the UDS constitutes a call state control function, especially given the Examiner also alleges that a different device, namely the service descriptor node, constitutes the CSCF.* And, it would be an even more egregious clear error to allege that Sanchez’s UDS teaches “registering, in a controller entity comprising a call state control function, a plurality of contact addresses for a user,” as recited in claim 1. Applicants respectfully point out that the European Patent Office has allowed the European counterpart to the instant application as evidenced by the IDS filed November 10,

¹ See *In re Suitco Surface, Inc.* (Fed. Cir. 2010) (finding that although the PTO is entitled to take the broadest reasonable construction of a claim term, the PTO’s construction cannot be unreasonable in view of the claim language and the specification).

2010.

Applicants are not surprised that Sanchez has the above-noted gap in its disclosure as Sanchez is directed to solving the problems of determining a correct home subscriber server from a plurality of home subscriber servers² rather than forking a communication link request to a user in parallel or sequentially to the contact addresses registered at a call state control function for that user.

Recognizing the shortcoming of Sanchez, the Examiner relies on Rosenberg. But Rosenberg does not cure the above-noted shortcomings of Sanchez. Nor does the Examiner allege that Rosenberg cures these noted deficiencies. Therefore, neither Sanchez nor Rosenberg discloses or suggests at least the following feature of claim 1: “registering, in a controller entity comprising a call state control function, a plurality of contact addresses for a user.”

B. Neither Sanchez nor Rosenberg discloses or suggests “receiving, at the controller entity, a request for a communication link to the user,” as recited in claim 1.

The Examiner has taken an unreasonable construction of the claimed “receiving, at the controller entity, a request for a communication link to the user.”³ In particular, the Examiner alleges that Sanchez’s disclosure at paragraphs 0012 and 0046 discloses the above-noted feature of claim 1 stating:

receiving, at the controller entity, a request for a communication link to the user is met here by Sanchez ([0046; 0012] e.g., call establishment ‘e.g., receiving and processing service requests from a Service Node or from another UDS in the resolution domain.

Office Action at page 3. But Sanchez does not disclose what the Examiner alleges. Paragraphs 0012 and 0046 of Sanchez instead describe the interface between the CSCF and the user distribution server (UDS), not receiving a request for a communication link to the user (which has registered a “plurality of contact addresses” as recited in claim 1). Given this gap in Sanchez, it would be unreasonable, and thus a clear error, to allege that Sanchez discloses “receiving, at the controller entity, a request for a communication link to the user,” as recited in claim 1. Moreover, Rosenberg does not cure the above-noted shortcomings of Sanchez. Nor does the Examiner allege that Rosenberg cures the noted deficiencies of Sanchez.

² See Sanchez at paragraphs 0009 and 0010 of published application.

³ See footnote 1.

C. Neither Sanchez nor Rosenberg discloses or suggests the claimed “processing means for processing, at the controller entity, the request based on the queried information from the database, wherein, when provided during registration, the controller entity uses user preference information to determine whether to fork the request in parallel or sequentially.”

The Examiner acknowledges Sanchez fails to disclose “the controller entity uses user preference information to determine whether to fork the request in parallel or sequentially.” Office Action on page 3. To cure that chasm in Sanchez, the Examiner relies on Rosenberg. Rosenberg discloses extracting explicit preferences from header fields of a request to determine caller preferences. Rosenberg at pages 18-19. When the caller preferences are not described in a header, the “proxy” extracts information from the request itself to form an implicit preference. Rosenberg at page 19. Thus, Rosenberg extracts information from a header rather than the claimed “when provided during registration, the controller entity uses user preference information to determine whether to fork the request in parallel or sequentially. Therefore, neither Sanchez nor Rosenberg discloses or suggests this noted feature of claim 1.

D. The proposed combination, which relies on Sanchez and Rosenberg, would fundamentally change the principle of operation of these reference and likely lead to an inoperative system.

“If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)).”⁴ Here, the fundamental principle of operation of SIP relies on a proxy extracting information from a request from a caller, which implicitly indicates the preferences of the caller. Rosenberg at pages 18-19. Therefore, there is no motivation for the Rosenberg proxy to subsequently contact a database at a home subscriber server to determine forking preferences, as the Examiner’s modifications would require. Moreover, modifying the proxy as the Examiner proposes would likely lead to an inoperative system as there might be conflicts in user preferences between the proxy’s “implicit” preferences and preferences found in a database.⁵

⁴ See, e.g., M.P.E.P 2143.03.

⁵ See also *Ex Parte Tofinss*, 2008 WL 4451384 (Bd. Pat. App. & Int 2008) (reversing the Examiner’s section 103 rejection as the proposed combination would yield an inoperative device).

Because there is no motivation to combine, the rejection under 35 U.S.C. § 103(a) of rejected claims 1, 4-5, 7-9, 11, 20, and 26-30 should be withdrawn for this additional reason.

New claims 31 and 32 are allowable for at least the reasons given above.

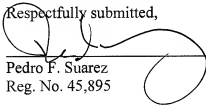
In view of A-D above, claim 1 is allowable over Sanchez and Rosenberg, whether taken alone or in combination, and the rejection under 35 U.S.C. §103(a) of claim 1 as well as claims 4, 5, 7-9, and 31-32 at least by reason of their dependency, should be withdrawn.

Independent claims 11 and 20, although of different scope, include similar features with respect to claim 1. For at least the reason given above with respect to claim 1, claims 11 and 20, as well as claims 25-30, at least by reason of their dependency, are allowable over Sanchez and Rosenberg, whether taken alone or in combination, and the rejection under 35 U.S.C. §103(a) of those claims should be withdrawn.

On the basis of the foregoing amendments, the pending claims are in condition for allowance. It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper.

Authorization for a credit-card payment of the filing fees mentioned above is submitted herewith. No additional fees are believed to be due, however the Commissioner is authorized to charge any additional fees or credit overpayments to Deposit Account No. 50-0311, reference No. 39700-793001US/NC39973US. If there are any questions regarding this reply, the Examiner is encouraged to contact the undersigned at the telephone number provided below.

Respectfully submitted,


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Date: February 9, 2011

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